

BY HAND

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Chung *et al.*

Application Nos.: 10/070,350 and  
10/069,586

(National Stage Application of International  
Application No. PCT/US00/14482)

Group Art Unit: To be assigned

Filed: February 27, 2002

Examiner: To be assigned

For: OSTEONECTIN BASED TOXIN  
GENE THERAPY FOR THE  
TREATMENT OF CALCIFIED  
TUMORS AND TISSUES

Attorney Docket No.: 9426-023-999

PETITION UNDER 37 C.F.R. §1.181 AND §1.10(c)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

On February 27, 2002, Applicants filed a Petition to Revive Abandoned National Stage Application Under 37 C.F.R. §1.137(b) ("Petition to Revive") in connection with International Application No. PCT/US00/14482. On March 28, 2002, the PCT Legal Administration at the United States Patent and Trademark Office ("USPTO") mailed a decision on the Petition to Revive ("the March 28, 2002 Decision"). The March 28, 2002 Decision, a copy of which is attached hereto as Exhibit 1, granted the Petition to Revive and assigned Application No. 10/070,350 to the national stage application of International Application No. PCT/US00/14482.

On July 7, 2002, the USPTO mailed a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) ("Notification of Missing Requirements") in connection with Application No. 10/070,350. A copy of the Notification of Missing Requirements is attached hereto as Exhibit 2.

On November 14, 2002, in accordance with the Rules of Practice for filing correspondence by "Express Mail" (37 C.F.R. §1.10(a)), Applicants deposited a Response to

the Notification of Missing Requirements and related documents (hereinafter, "the Deposited Correspondence") with the United States Postal Service ("U.S.P.S."). Applicants used the U.S.P.S. "Express Mail Post Office to Addressee" service and paid sufficient postage therefor. The Express Mail Label No. was EL 500 576 834 US.

However, it has recently come to the attention of Attorneys for Applicants that **two application numbers have now been associated with the national stage application of International Application No. PCT/US00/14482**. Specifically, on January 6, 2003, the PCT Legal Administration at the USPTO mailed another decision on the Petition to Revive ("the January 6, 2003 Decision"). The January 6, 2003 Decision, a copy of which is attached hereto as Exhibit 3, granted the Petition to Revive for the second time and assigned a second Application No. 10/069,586 to the national stage application of International Application No. PCT/US00/14482.

Accordingly, Applicants respectfully request that the files in connection with the two application numbers, *i.e.*, 10/070,350 and 10/069,586, be merged into one file.

In addition, on December 6, 2002, Applicants submitted a Request to Establish Small Entity Status, Assertion of Small Entity Status Under 37 C.F.R. §1.27(a)(1) and 1.27(c), and Request for Refund Under 37 C.F.R. §1.28(a) of fees paid on November 14, 2002 ("Request"). On February 11, 2003, the Office of Petitions of the USPTO mailed a decision on the Request ("the February 11, 2003 Decision"). The February 11, 2003 Decision, a copy of which is attached hereto as Exhibit 4, indicated that a request for extension of time has not been received in the USPTO on November 14, 2002. Thereafter, on February 26, 2003, Attorneys for Applicants telephoned the USPTO and were notified that the USPTO has no record of receipt of the deposited communication filed November 14, 2002.

As a result, in addition, Applicants hereby petition the Commissioner under 37 C.F.R. §1.10(c) to accord the filing date of the Deposited Correspondence in the USPTO the U.S.P.S. deposit date of November 14, 2002. The facts in support of these petitions are provided below.

**1. This petition is being filed promptly in accordance with 37 C.F.R. §1.10(c)(1)**

Attorneys for Applicants only recently became aware that the USPTO records do not reflect receipt of the Deposited Correspondence filed November 14, 2002. The Deposited

Correspondence, a true copy of which, is attached as Exhibit 5 hereto, consisted of the following:

- (1) return postcard ("Postcard Receipt"), which on one side had an itemized list of the papers mailed on November 14, 2002, and Express Mail Label No. EL 500 576 834 US;
- (2) Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) with copy of Notification;
- (3) Petition for Extension of Time Under 37 C.F.R. §1.136(a) for 3 months together with authorization for the required fee;
- (4) Preliminary Amendment Under 37 C.F.R. §1.115 with Exhibit A, a marked-up version of the amended paragraphs of the specification; and
- (5) Transmittal of Sequence Listing Under 37 C.F.R. §1.821 and Sequence Listing on paper and computer readable form.

In particular, the Petition for Extension of Time for 3 months submitted November 14, 2002 included an authorization for the required fee as a non-small entity, *i.e.*, \$ 920.

The Express Mail package deposited by Attorneys for Applicants on November 14, 2002, using Express Mail Label No. EL 500 576 834 US, included several other sets of correspondence relating to already pending applications. Upon this discovery, Attorneys for Applicants telephoned the USPTO to determine whether there was any record of the Deposited Correspondence being delivered. The USPTO computer database does not reflect that the Deposited Correspondence has been received.

This petition is therefore being filed promptly after Attorneys for Applicants became aware that the USPTO had no record of the Deposited Correspondence filed November 14, 2002 in accordance with 37 C.F.R. §1.10(c)(1) despite the fact that Applicants received a stamped Postcard Receipt dated November 14, 2002 evidencing receipt of the Deposited Correspondence by the USPTO (see below Exhibit 6).

**2. The Express Mail Mailing Label No. EL 500 576 834 US was placed on the Deposited Correspondence in accordance with 37 C.F.R. §1.10(c)(2)**

As demonstrated by the true copy of the Deposited Correspondence attached as Exhibit 5, the first page of the Response to Notification of Missing Requirements Under 35

U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), the Petition for Extension of Time Under 37 C.F.R. §1.136(a), the first page of the Preliminary Amendment Under 37 C.F.R. §1.115, the Transmittal of Sequence Listing Under 37 C.F.R. §1.821, and the Postcard Receipt itemizing the correspondence contents all included the Express Mail Label No. EL 500 576 834 US at the top right hand corners of those sheets. As a result, the Express Mail Label No. EL 500 576 834 US was placed on the Deposited Correspondence prior to it being deposited with the U.S.P.S. in accordance with 37 C.F.R. §1.10(c)(2).

**3. The necessary supporting documentation is attached to this petition in accordance with 37 C.F.R. §1.10(c)(3)**

As indicated above, a true copy of the Deposited Correspondence is attached as Exhibit 5 hereto and demonstrates that the Deposited Correspondence showed the relevant Express Mail Label No. EL 500 576 834 US. A copy of the Postcard Receipt of the Deposited Correspondence showing a USPTO stamped receipt date of November 14, 2002 is attached hereto as Exhibit 6.

In addition, in accordance with 37 C.F.R. §1.10(c)(3), a true copy of the Post Office to Addressee Express Mail Mailing Label No. EL 500 576 834 US is attached hereto as Exhibit 7. In the Date In box, the Express Mail mailing label clearly shows the "date in" as being the requested filing date of November 14, 2002. The Express Mail mailing label also bears a U.S.P.S. stamp verifying November 14, 2002 as the date of deposit with the U.S.P.S. The mailing label additionally indicates that the sender is Attorney for Applicants, Pennie & Edmonds LLP, 1155 Avenue of the Americas, 17th Fl., New York, NY 10036-2711; that the recipient is the Assistant Commissioner for Patents, Washington DC, 20231-9999; and that sufficient postage of \$34.15 was paid.

Furthermore, a true copy of the Express Mail Certification dated November 14, 2002 and signed by an employee of Attorney for Applicants, Anthony Ali, is attached hereto as Exhibit 8. Information regarding attorney name and attorney docket numbers for other correspondence not related to this application has been redacted to preserve the confidentiality of that information in the remaining table entries of the Express Mail Certification. The Express Mail Certification indicates that the Deposited Correspondence corresponding to the attorney name Baldwin and attorney docket no. 9426-023-999 in the 3rd table entry of that document, was inserted into the Express Mail package corresponding to the

Express Mail Label No. EL 500 576 834 US. and that this package was deposited with the U.S.P.S. using "Express Mail Post Office to Addressee" service on November 14, 2002.

Finally, Applicants submit that copies of the February 11, 2003 Decision in Exhibit 4, the Deposited Correspondence in Exhibit 5, the returned stamped Postcard Receipt in Exhibit 6, the Post Office to Addressee Express Mail Mailing Label No. EL 500 576 834 US in Exhibit 7, and the Express Mail Certification in Exhibit 8 are all true copies of the respective original documents.

Accordingly, Applicants respectfully submit that all of the requirements of 37 C.F.R. §§1.10(a) and (c) have been fully met and complied with, and that therefore the Deposited Correspondence in Exhibit 5 – including the Response to Notification of Missing Requirements contained therein – should be accorded a filing date of November 14, 2002, which is the date of deposit of that correspondence as Express Mail with the U.S.P.S.

It is believed that no fee is required in connection with this petition. However, should the USPTO determine otherwise, please charge any necessary fee to Pennie & Edmonds LLP deposit account no. 16-1150.

Respectfully submitted,

Date March 11, 2003

 31.232  
Geraldine F. Baldwin (Reg. No.)

**PENNIE & EDMONDS LLP**  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

Enclosures

MAR 28 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

S/S

Pennie & Edmonds  
1667 K Street, N.W.  
Suite 1000  
Washington, DC 20006

APR 01 2002

In re Application of  
CHUNG, Leland W.K., et al.  
Application No.: 10/070,350  
PCT Application No.: PCT/US00/14482  
International Filing Date: 25 May 2000  
Priority Date: 28 May 1999  
Attorney Docket No.: 9426-023-999

For: OSTEONECTIN BASED TOXIC GENE  
THERAPY FOR TREATMENT OF CALCIFIED  
TUMORS AND TISSUES

DECISION ON

PETITION

UNDER 37 CFR 1.137(b)

Applicants' "Petition to Revive Abandoned National Stage Application Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 27 February 2002 is **GRANTED**.

### **BACKGROUND**

On 25 May 2000, applicants filed an international application, No. PCT/US00/14482, which claimed a priority date of 28 May 1999.

On 20 December 2000, a demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. The deadline for entry into the United States National Stage was thirty months from the priority date, that is 28 November 2001.

On 27 February 2002, applicants filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, a petition to revive and the basic national fee.

### **DISCUSSION**

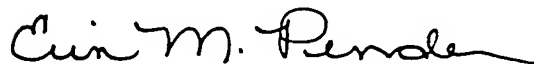
A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicants' statement that "the entire delay in filing ... [the proper reply] from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfies the requirements of 37 CFR 1.137(b)(3). Applicants have authorized the Office to charge the appropriate fees to Deposit Account No. 16-1150. A terminal disclaimer is not required as application was filed on 25 May 2000. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

### CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is GRANTED as to the National Stage in the United States of America.

This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing, including preparation of a Notification of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required.



Erin M. Pender  
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PCT Legal Administration



Richard Cole  
PCT Legal Examiner  
PCT Legal Administration

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UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/070,350		9426-023-999

INTERNATIONAL APPLICATION NO.

PCT/US00/14482

I.A. FILING DATE

05/25/2000

PRIORITY DATE

05/28/1999

 PENNIE & EDMONDS  
 1667 K STREET, N. W.  
 WASHINGTON, DC 20006

CONFIRMATION NO. 9987

371 FORMALITIES LETTER



\*OC00000008410486\*

*Declaration due 9-9-02 (9)*  
*Sequence listing due 9-9-02 LH*

Date Mailed: 07/09/2002

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Oath or Declaration
- Request for Immediate Examination

SYS

JUL 15 2002

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
  - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).



The following items **MUST** be furnished within the period set forth below:

- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
- **APPLICANT MUST PROVIDE:**
  - An initial or substitute computer readable form (CRF) of the "Sequence Listing."

- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (703) 308-4216
- To Purchase PatentIn Software, call (703) 306-2600
- For PatentIn Software Program Help, call (703) 306-4119 or e-mail at [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or [patin3help@uspto.gov](mailto:patin3help@uspto.gov)

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

CHRISTINE S WASHINGTON

Telephone: (703) 305-3752

**PART 1 - ATTORNEY/APPLICANT COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/070,350	PCT/US00/14482	9426-023-999

6 JAN 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D. C. 20231  
www.uspto.gov

Pennie & Edmonds LLP  
1667 K Street, NW, Suite 1000  
Washington, DC 20006

In re Application of  
Chung et al.

Application No. 10/069586 - ?

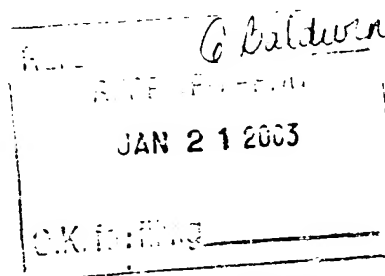
✓ PCT No.: PCT/US00/14482

✓ Int. Filing Date: 25 May 2000

✓ Priority Date: 28 May 1999

✓ Atty. Docket No.: 9426-023-999

For: Osteonectin Based Toxic Gene  
Therapy For The Treatment Of  
Calcified Tumors And Tissues



DECISION ON

PETITION UNDER

37 CFR 1.137(b)

This is in response to the petition under 37 CFR 1.137(b) filed on 27 February 2002.

### **BACKGROUND**

This international application was filed on 25 May 2000 and claimed earliest priority of an application filed on 28 May 1999. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 28 November 2001. This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

On 27 February 2002, applicants filed the instant petition.

### **DISCUSSION**

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. The petition satisfies requirements (2), (3) and (4) but does not satisfy requirement (1).

Regarding requirement (1), the petition was accompanied by the required reply in the form of the basic national fee.

Regarding requirement (2), the petition was accompanied by the petition fee.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the

international filing date of this application is later than 8 June 1995.

**DECISION**

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b).



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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 7

**PENNIE & EDMONDS**  
**1155 AVENUE OF THE AMERICAS**  
**NEW YORK, NY 10036-2711**

COPY MAILED

FEB 11 2003

OFFICE OF PETITIONS

In re Application of :  
Leland W.K. Chung et al :  
Application No. 10/070,350 :  
PCT Application No. PCT/US00/14482 :  
International Filing Date: May 25, 2000 :  
Priority Date: May 28, 1999 :  
Attorney Docket No. 9426-023-999 :

LETTER

This is in response to the paper filed December 6, 2002 under 37 CFR 1.27(c) seeking status as a small entity. This is also a decision on the request for refund filed November 14, 2002.

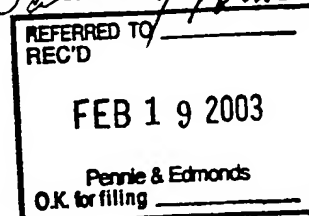
An assertion for small business concern filed December 6, 2002 has been made of record and small entity status has been accorded.

The request for refund of the extension of time is dismissed.

A review of the Office Finance records does not indicate a request for extension of time has been received in the USPTO on November 14, 2002.

The application file is being forwarded to the United States Designated/Elected Office.

*Wan Laymon*  
Wan Laymon  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy



Express Mail No.: **EL 500 576 834 US**

First Class Mail ( )

Date Mailed: **November 14, 2002**

Serial No.: **10/070,350**

Filed: **February 27, 2002**

Inventor: **Chung et al.**

For: **OSTEONECTIN BASED TOXIC GENE THERAPY FOR THE  
TREATMENT OF CALCIFIED TUMORS AND TISSUES**

*The stamp of the Patent Office hereon may be taken as an acknowledgment of the date stamped of the following:*

- (X) Response to Notification of Missing Requirements Under 37 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) with copy of Notification;
- (X) Petition for Extension of Time for (3) months from September 9, 2002 to and including December 9, 2002 with fee;
- (X) a Preliminary Amendment under 37 C.F.R. §1.115 with Exhibit A; a marked up version of the amended paragraphs of the specification;
- (X) Transmittal of Sequence Listing under 37 C.F.R. §1.821 in paper and computer readable form.

**File No. 9426-023-999** **Sender: GFB/rer**